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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,971	10/28/2003	Yasuhiro Oshima	ITECP003	8001
25920 7590 08/06/2008 MARTINE PENILLA & GENCARELLA, LLP 710 LAKEWAY DRIVE SUITE 200 SUNNYVALE, CA 94085				
EXAMINER				
SHRESTHA, BLEENDRA K				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/695,971

**Applicant(s)**

OSHIMA ET AL.

**Examiner**

BIJENDRA K. SHRESTHA

**Art Unit**

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 01/31/2005 and 07/07/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_



### **DETAILED ACTION**

Claims 1-32 are presented for examination. With response to restriction requirement set by the Examiner, Applicant elected Group I, claims 1-18 without traverse in a reply filed on April 21, 2008. Claims 19-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention.

### ***Priority***

Acknowledgement is made of applicant's claim for foreign priority to Japanese Application JAPAN 2002-312469 and 202-312470 filed on 10/28/2002. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a certified English translation of the foreign application must be submitted in reply to this action. 37 CFR 41.154(b) and 41.202(e).

Failure to provide a certified translation may result in no benefit being accorded for the non-English application.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1-9 recite "a commodity sales system comprising ....a commodity price specification module...; ....a quote determination module...; a deduction setting

module...; a difference calculation module....; and an amount payable notification module...." Modules not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. Here, Applicant has claimed a system defined merely by software or terms synonymous with software or files, namely "modules", lacking storage on a medium, which enables any underlying functionality to occur. It is not clear whether instructions are in executable form and therefore there is no practical application. The system has no physical components or structure and is thus considered non-statutory.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-9 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, claim 1 recites in the preamble "a commodity sales system", the body of the claim does not contain any limitations indicating the structure of the system. A system or an apparatus claim should always claim the structure or the hardware that performs the function. Applicant's claimed limitations consist of modules (software

according to the specification) that do not describe the structure of the device.

Appropriate correction is required.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 11, 12, 20-23 and 28-30 of copending Application No. 10/674,988. Although the conflicting claims are not identical, they are not patentably distinct from each other because '988 application claims 1, 5, 11, 12, 20-23 and 28-30 teach the elements in claims 1-19 in the instant application.

This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

As per claims 1-18 of instant application, claims 1, 5, 11, 12, 20-23 and 28-30 of applications '988 teach used article quotation system and method that provides user computer with a quote for acceptance of a used article for trade-in for purchase of a product.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Asami et al., U.S. Pub No. 2001/0005833 (reference A in attached PTO-892).

7. As per claim 1, Asami et al. teach a commodity sales system that is connected with a user computer in a communicable manner and is used when a user purchases a commodity (see Fig. 1), said commodity sales system comprising:

a commodity price specification module that receives a purchase request of a selected commodity from the user computer and specifies a commodity price of the selected commodity (see Fig. 8, Product Selection Page (116), Selling Price; Fig. 9)

a quote determination module that receives a trade-in request of a used article and quotation requirement information, which is required for quotation of the used article, from the user computer and determines a trade-in quote of the used article, based on the received quotation requirement information (see Fig. 7 and Fig. 15; paragraphs [0119-0121]; where resale prices of used items owned by user);

a deduction setting module that sets a deduction of the selected commodity, which is to be subtracted from the specified commodity price of the selected commodity, according to the trade-in quote of the used article thus determined (see Fig. 18, paragraph [0148]);

a difference calculation module that subtracts the setting of the deduction from the specified commodity price of the selected commodity to calculate a difference (see Fig. 17, Price Difference Calculation (212); Fig. 18, Show Price Difference; paragraph [0148]); and  
an amount payable notification module that notifies the user computer of the calculated difference as an amount payable (see Fig. 19, Reference Price with Trade-in Credit: 100,000; paragraph [0149]).

8. As per claim 2, Asami et al. teach claim 1 as described above. Asami et al. further teach the system wherein

said deduction setting module sets the deduction to be not less than a preset support price (see Fig. 16; where deduction is based on resale price upper limit).

9. As per claim 3, Asami et al. teach claim 1 as described above. Asami et al. further teach the system wherein

said quote determination module, in response to receipt of the trade-in quote of the used article and the quotation requirement information, which is required for quotation of the used article, specifies a tentative quote of the used article based on the quotation requirement information, compares the specified tentative quote with a predetermined reference value, and determines either a price having a value range or a price having no value range as the trade-in quote of the used article according to a result of the comparison (see Fig. 16; where predetermined reference value is resale price upper limit =Y 160.00 and trade-in quote is assessment price = Y153.00).



said deduction setting module sets the deduction of the selected commodity corresponding to a minimum value in the value range of the price when the price having the value range is determined as the trade-in quote of the used article, while setting the deduction of the selected commodity corresponding to the price having no value range when the price having no value range is determined as the trade-in quote of the used article (see Figs. 15-16; where deduction setting module assess used article and deduction is depend upon scratches or defects and value range is Y 0 – Y160.00).

10. As per claim 4, Asami et al. teach claim 3 as described above. Asami et al. further teach the system wherein

the predetermined reference value is used to determine whether an assessment of the used article is required to settle a final trade-in price of the used article (see Fig. 16; where predetermined reference value is resale price upper limit).

11. As per claim 5, Asami et al. teach claim 3 as described above. Asami et al. further teach the system wherein

said deduction setting module sets the deduction of the selected commodity corresponding to the minimum value in the value range of the price, and when a final trade-in price settled after an assessment of the used article exceeds the minimum value, said amount payable notification module notifies the user computer of a refund corresponding to a difference between the final trade-in price and the minimum value, together with the amount payable (see Fig. 19; where trade-in amount is deducted from the main unit price; Examiner notes the refund to user or payment by user depends upon cost of new unit purchased by the user).

12. As per claim 6, Asami et al. teach claim 3 as described above. Asami et al. further teach the system wherein

said quote determination module, in the case where the price having no value range is determined as the trade-in quote of the used article, based on the result of the comparison between the tentative quote and the predetermined reference value, determines either a settled price having no value range, which depends upon the tentative quote, as the trade-in quote of the used article or a preset fixed price, which does not depend upon the tentative quote, as the trade-in quote of the used article according to a value level of the tentative quote (see Fig. 16).

13. As per claim 7, Asami et al. teach claim 1 as described above. Asami et al. further teach the system wherein

said deduction setting module, in the case where said quote determination module determines trade-in quotes of multiple used articles, sets a total deduction of the selected commodity, which is to be subtracted from the specified commodity price of the selected commodity, according to a sum of the trade-in quotes of the multiple used articles or a sum of deductions set for the respective used articles (see Fig. 18; where total trade-in amount represents total cost multiple used articles).

14. As per claim 8, Asami et al. teach claim 1 as described above. Asami et al. further teach the system comprising:

an adjustment module that adjusts the difference calculated by said difference calculation module to be not less than a predetermined value (see Fig. 16; where resale price is adjusted for extent of defects or scratches in the used article).

15. As per claim 9, Asami et al. teach claim 8 as described above. Asami et al. further teach the system, wherein

said adjustment module comprises a transmission sub-module that is activated to send the user computer a message showing that the trade-in request of the used article is not acceptable, instead of said amount payable notification module (see Fig. 19; where assessment of used article may result no value and user may have to pay full price for main unit purchased).

16. As per claim 10, Asami et al. teach a commodity sales method that is carried out when a user purchases a selected commodity, said commodity sales method comprising the steps of:

(a) causing a server computer to receive a purchase request of a selected commodity from the user computer and specify a commodity price of the selected commodity (see Fig. 8 and 9);

(b) causing the server computer to receive a trade-in request of a used article and quotation requirement information, which is required for quotation of the used article, from the user computer and determine a trade-in quote of the used article, based on the received quotation requirement information (see Fig. 11) ;

(c) causing the server computer to set a deduction of the selected commodity, which is to be subtracted from the specified commodity price of the selected commodity, according to the trade-in quote of the used article thus determined (see Fig. 17 and 18);

d) causing the server computer to subtract the setting of the deduction from the specified commodity price of the selected commodity to calculate a difference; and (e) causing the server computer to notify the user computer of the calculated difference as an amount payable (see Fig. 19).

17. As per claim 11, Asami et al. teach claim 10 as described above. Claim 11 is rejected under same rational as claim 2 described above.

18. As per claim 12, Asami et al. teach claim 10 as described above. Claim 12 is rejected under same rational as claim 3 described above.

19. As per claim 13, Asami et al. teach claim 12 as described above. Claim 13 is rejected under same rational as claim 4 described above.

20. As per claim 14, Asami et al. teach claim 12 as described above. Claim 14 is rejected under same rational as claim 5 described above.

21. As per claim 15, Asami et al. teach claim 12 as described above. Claim 15 is rejected under same rational as claim 6 described above.

22. As per claim 16, Asami et al. teach claim 10 as described above. Claim 16 is rejected under same rational as claim 7 described above.

23. As per claim 17, Asami et al. teach claim 10 as described above. Claim 17 is rejected under same rational as claim 8 described above.

24. As per claim 18, Asami et al. teach claim 17 as described above. Claim 18 is rejected under same rational as claim 9 described above.

### ***Conclusion***

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosures. The following are pertinent to current invention, though not relied upon:

Ellenson et al. (U.S. Pub No. 2003/0200151) teach system and method for facilitating the real-time pricing, sale and appraisal of used vehicles.

Katada et al. (U.S. Pub No. 2004/0230504) teach apparatus unit replacement assisting method and system.

Ly et al. (U.S. patent No. 7,216,094) teach web vehicle ordering system.

Gilbert et al. (U.S. Pub No. 2003/0126062) teach system and method for creating and trading dynamic securities.

Magouirk et al. (U.S. Patent No. 6,941,305) teach customer management system for automobile sales industry.

Seretti et al. (U.S. Patent No. 5,978,776) teach vehicle data exchange system and method therefor.

Takaoka et al. (U.S. Pub No. 2002/099628) teach estimated price providing apparatus, system, method and computer program and computer readable medium.

Walker et al. (U.S. Pub No. 2007/0219868) teach system and method for offering multiple products.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bijendra K. Shrestha whose telephone number is (571)

270-1374. The examiner can normally be reached on 7:00 AM-4:30 PM (Monday-Friday); 2nd Friday OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BKS/3691

/Hani M. Kazimi/  
Primary Examiner, Art Unit 3691

